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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,684	10/17/2003	Hiroki Fujihira	NANP113US	9339
23623	7590	07/26/2006	EXAMINER	
AMIN, TUROCY & CALVIN, LLP 1900 EAST 9TH STREET, NATIONAL CITY CENTER 24TH FLOOR, CLEVELAND, OH 44114			CEPERLEY, MARY	
			ART UNIT	PAPER NUMBER
			1641	

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/687,684

Applicant(s)

FUJIHIRA ET AL.

Examiner

Mary (Molly) E. Ceperley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2 and 4-6 is/are allowed.
- 6) ☒ Claim(s) 1 and 3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1) A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 18, 2006 has been entered.

2) Receipt from applicants of an English language translation of Japanese Laid Open Patent Publication No 10-101615 on May 18, 2006 is acknowledged with appreciation.

3) Claims 2 and 4-6 are allowed.

4) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5) Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over the English language translation of Kawada et al JP 10101615 {see form PTO-892; translation provided by applicants}. This rejection is equivalent to the rejection of record made over the English abstract HCAPLUS 1998: 239541 describing JP 0101615 {see paragraphs **5)** and **6)** of the January 18, 2006 Office action}.

The compound of formula II of Kawada et al wherein B = (CH₂)₃ renders obvious the claimed structural homologues depicted by formula (I) of claim 1 of this application {see the (CH₂)_n moiety of the compound of formula (I) of claim 1 wherein n = 5-10}. Given the close structural similarity with the compounds of the prior art, the claimed compounds would be expected to have similar properties to the

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compound of the prior art. See MPEP 2144.09. Similarly, the corresponding claimed immunogens of formula (II) of claim 3 of this application are rendered obvious by the homologous immunogens of Kawada et al {see paragraphs [0037] – [0043]}. The well known reaction between the carboxylic acid group of the Kawada et al activated hapten and an amine group of either BSA or KLH (both well known immunogenic peptides) results in the formation of an amide bond (-CONH-) corresponding to the amide bond shown in the structure of formula (II) of claim 3 of this application.

6) Applicants are advised that a showing of at least one of the following results might be useful to establish non-obviousness of the claimed compounds over the homologues of the reference.

a) A showing that the claimed compounds are not useful to prepare antibodies having specificity for phenoxyacetic acid.

b) A showing that the compounds of the reference are not useful to prepare antibodies having specificity for dioxins.

c) A showing that antibodies produced from the claimed immunogens have improved specificity for phenoxyacetic acid relative to the antibodies produced from the immunogens of the prior art.

7) Applicant's arguments filed May 18, 2006 have been fully considered but they are not persuasive.

a) Applicants have not substantiated the statement made in the May 18, 2006 Remarks at page 8 that "an antibody obtained using the claimed compound of formula (I) would not specifically bind the phenoxyacetic acids" {see also, the last paragraph of page 18 (1) of the May 18, 2006 Remarks}. The verification of this statement might be useful in establishing the non-obviousness of the claimed compounds {see paragraph **6)a)** above}.

b) Applicants' cite *Ex parte Blattner* {page 9 of the May 18, 2006 Remarks}, a case in which the prior art homologues "possessed the opposite utility" from the claimed compounds

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thus precluding the establishment of obviousness of the claimed compounds over the prior art compounds. However, applicants have not established such an "opposite utility". See paragraphs **6)a)** and **6)b)** above.

c) Applicants' argument regarding the expectations of an *alternate utility* for the reference compounds has no direct bearing on the obviousness of the claimed compounds {May 18, 2006 Remarks, the last paragraph of page 14}. In the absence of evidence to the contrary {see paragraph **6)** above}, the claimed compounds would be expected to have the same utility as the reference compounds. Applicants have not established that the claimed compounds do not have the same utility as the reference compounds, i.e. utility as antigens for the preparation of phenoxyacetic acid-specific antibodies.

d) With regard to structural differences between the claimed and reference compounds {Remarks, page 9, the second full paragraph}, it is the examiner's position that the closest prior art compound is formula II wherein B is "trimethylene" $\{-(CH_2)_3-\}$ and that non-obviousness relative to this closest prior art compound must be established {see paragraph **6)** above}. The claimed 2, 4, 5-trichloro substitution is clearly described by Kawada et al as being a preferred substitution {see Kawada et al, paragraph [0023] and Table 1 of page 31} and thus there would be motivation to make and use the particular 2, 4, 5-trichloro substituted compound contrary to applicants' contention that there would be no such motivation {Remarks: page 11, the last paragraph and page 10, the last paragraph}.


8) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary (Molly) E. Ceperley whose telephone number is (571) 272-0813. The examiner can normally be reached from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le, can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 21, 2006


Mary (Molly) E. Ceperley
Primary Examiner
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